



TRANSMITTAL OF APPEAL BRIEF (Small Entity)

Docket No.
GGG-10003/29

In Re Application Of: Gochanour

Serial No.
09/110,987Filing Date
July 7, 1998Examiner
G. BaeGroup Art Unit
3724

Invention: PROTECTIVE HAND COVERING AND DISPENSER APPARATUS

TO THE ASSISTANT COMMISSIONER FOR PATENTS:

Transmitted herewith in triplicate is the Appeal Brief in this application, with respect to the Notice of Appeal filed on:
June 26, 2001

Applicant is a small entity under 37 CFR 1.9 and 1.27.

A verified statement of small entity status under 37 CFR 1.27:

- ☐ is enclosed.
- ☒ has already been filed in this application.

The fee for filing this Appeal Brief is: \$155.00

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Dated: Aug. 27, 2001

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CC:



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application of: Gochanour

Serial No.: 09/110,987

Art Unit: 3724

Filed: July 7, 1998

Examiner: G. Bae

For: PROTECTIVE HAND COVERING AND DISPENSER APPARATUS

APPEAL BRIEF UNDER 37 C.F.R. §1.192

Box AF
Assistant Commissioner for Patents
Washington, D.C. 20231

Dear Sir:

This is Appellants' Appeal Brief to the Board of Appeals in response to the final Office Action dated March 30, 2001, and the subsequent Notice of Appeal mailed June 26, 2001.

I. Real Party in Interest

The real party in interest in this case is Gary Gochanour, an independent inventor.

II. Related Appeals and Interferences

There are no related appeals or interferences known to Appellant or Appellant's legal representative affected by, or which might have a bearing, on the Board's decision with respect to this appeal.

III. Status of the Claims

Claims 1-3, and 5-9 are pending in this application. Claims 1-3, 5, 6 and 8 are rejected; claims 7

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and 9 are objected to.

IV. Status of all Amendments Filed Subsequent to Final Rejection

An after-final amendment was filed on May 30, 2001 canceling claim 8 and modifying claim 9. As indicated in the Advisory Action (Paper No. 15), the Examiner stated that the amendment was "not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal."

V. Concise Summary of the Invention

The invention as claimed resides in a dispenser for a thin, flexible protective hand covering film (see Abstract). Figure 5A illustrates a preferred configuration in skeletal form. A roll of flexible adhesive film 51 is installed into a housing 52. The film is drawn from the roll over a platform area 54, terminating in an edge 55 adapted to snag, cut or otherwise sever the film into individual sheets (Specification, page 16, lines 14-23). Once surface of the film is supplied with a preferably low-tack adhesive, and is drawn from the roll with this tacky surface facing outwardly, enabling a user to press the palmer surface of a hand against the film to produce temporary covering (see Figure 2). Figures 6A-6C illustrate the way in which a user would apply a section of the film utilizing the dispensers of Figures 5A-5C. In Figure 6B, having made contact to the sheet of film, the user may detach the sheet using a supplied cutter or other capability, resulting in a detached sheet adhered to the hand, as shown in Figure 6C.

VI. Concise Statement of Issues Presented for Review

- A. Was claim 8 properly rejected under 35 U.S.C. §112, second paragraph, on the grounds that it is “unclear” how defining the workpiece further defines the claimed invention”?
- B. Were claims 1-3 and 5-6 properly under 35 U.S.C. §103(a) over Garr (U.S. Patent No. 4,607,774) in view of Stoller (U.S. Patent No. 3,229,875)?

VII. Grouping of Claims for Each Ground of Rejection Which Appellant Contends

For the purposes of this appeal brief, claims 2, 3, 5, 6 and 8 stand or fall with claim 1.

VIII. Argument

A. Is the Rejection Under 35 U.S.C. §112, Second Paragraph, Proper Over Appellant’s Use of the Term “Substantially”

Apart from the fact that this term is widely used in the drafting of patent claims, the authorities have held that “substantially” is definite in view of the general guidelines contained in the specification. (MPEP §2173.05(b)(D).) Accordingly, Appellant respectfully requests that this rejection under §112 be withdrawn.

B. Is Claim 1, and the Claims That Stand or Fall Therewith, obvious Over Garr In View of Stoller?

The Appellant disagrees with the Examiner’s position that the claimed invention is obvious over the combination of U.S. Patent No. 4,607,774 to Garr and U.S. Patent No. 3,229,875 to Stoller. As a first issue, there is no motivation in the prior art for combining the two references. In rejecting claims

under 35 U.S.C. §103, the Examiner must provide a reason why one having ordinary skill in the pertinent art would have been led to modify the prior art, or to combine references, to arrive at Appellant's claimed invention. There must be something *in the prior art* that suggested the combination, other than the hindsight gained from knowledge that the inventor choose to combine these particular things in this particular way. Uniroyal Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988). The Examiner is also required to make specific findings on a suggestion to combine prior art references. In Re Dembeczak, 175 F.3d 994, 1000-01, 50 USPQ2d 1614, 1617-19 (Fed. Cir. 1999).

Garr merely discloses a wrapping table to dispense plastic film. It is not directed to dispensing film with an adhesive on one surface or to dispensing film to be placed on the hand of an adult user. In addition, Garr lacks a base member applicable for the purpose of placing the palmar surface of an adult hand for adhesion by the film. The Garr disclosure does not motivate a combination with the device of Stoller. Stoller narratively discloses a dispenser for flexible plastic articles but does not show anything that would allow a user to place an adhesive coated sheet on to a human hand.

The present invention discloses a novel dispenser that allows application of an adhesive coated plastic film to an adult hand. Neither of the cited references disclose or suggest a solution to this problem nor in any way motivate a solution. Even if the two references were combined, despite the lack of motivation in the prior art, the combination does not provide anything close to the present invention. Instead, the combination merely provides a dispenser for non-adhesive plastic film with no provision for attaching the film to a human hand.

The Examiner makes the argument that the difference between the combination of Stoller and Garr, and the present invention, is merely a matter of a change in size. On the contrary, the present

invention provides an entirely different configuration than either of the cited references or some combination of the two. Neither reference provides a space for the palm of a hand to contact the sheeted material. Garr provides only a very small area that may be considered some type of base, although this area is certainly not designed, configured or sized for the purpose of the present invention.

Even if the difference between the cited combination and the present invention were merely a matter of size, this does not make the present invention obvious. The Examiner cites In re Rose, 105 USPQ 237 (CCPA 1955) for the proposition that a change in size is generally recognized as being within the level of ordinary skill in the art. This is true only where the change in size provides no unexpected benefit. In the present case, the configuration of the present invention provides a completely different utility than either of the cited references. Even if this were "merely a change in size," this change has resulted in the creation of an entirely new invention.

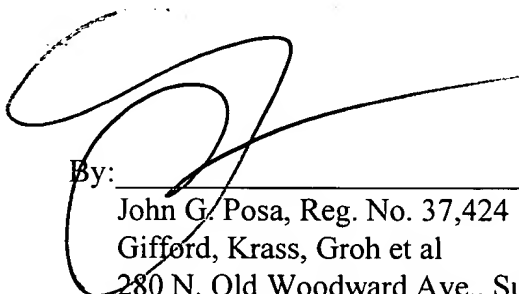
The Examiner also argues that the use of resilient base member is merely an obvious change in material and cites In re Leshin, 125 USPQ 416. Presumably, this argument is directed towards Appellant's claim 6 where the base member is specified to be resilient. This is not merely a matter of a change in materials that does not result in a change in the device. Instead, the resilient base material allows a person to "grip" the adhesive coated plastic sheet against the resilient base material allowing a better adhesion between the plastic sheet and the person's hand. If the material of the Garr device were changed from a steel material to a resilient material, the usefulness of the device would be seriously hampered. The device would no longer be operable to support an object to be wrapped on the wrapping table. As stated by the Supreme Court in Smith v. Goodyear Dental Vulcanite, 93 US 496 (1876), if "such a substitution involves a new mode of construction, or develops new uses and properties of the article formed, it may amount to invention...It may require contrivance, in which case the mode of

making it would be patentable; or the result may be the production of an analogous but substantially different manufacture... where there is some such new and useful result, where a machine has acquired new functions and useful properties, it may be patentable as an invention, though the only change made in the machine has been supplanting one of its materials by another. This is true of all combinations, whether they be of materials or processes. This is clearly the case in the present invention where the change in material makes a device that has entirely different utility than either of the cited references.

Conclusion

Based on the foregoing, all rejected claims continue to be in condition for allowance.

Respectfully submitted,



By: _____

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Dated: Aug. 27, 2001

APPENDIX - APPEALED CLAIMS

1. A dispenser for a roll of flexible stretchable film to be used as a hand covering, the roll of film defining a central axis, and having first and second surfaces, with the first surface including an applied adhesive, the dispenser comprising:

a housing to receive the roll of film;

an edge operative to separate the film drawn off the roll into individual sheets for use; and

a base member between the roll and the edge over which the film is drawn, with the first surface facing outwardly, and wherein the base member defines an area of at least 40 square inches to permit placement of the palmar surface of an average adult human hand thereagainst to be covered by the flexible, stretchable film.

2. The dispenser of claim 1, further including an aperture through which the film may be pulled and drawn off the roll.

3. The dispenser of claim 1, wherein the flexible film includes spaced-apart perforation regions, and wherein the edge is physically configured to separate the drawn film into individual sheets at the perforation regions.

5. The dispenser of claim 1, wherein the base member is substantially non-resilient.

6. The dispenser of claim 1, wherein the base member is substantially resilient.

7. The dispenser of claim 1, wherein the base member includes a hand-shaped depression oriented toward the film.

8. The dispenser of claim 1, wherein the flexible film is at least partially transparent, enabling a user to visualize the base member therethrough.

9. The dispenser of claim 8, wherein the base member includes hand-positioning visual indicia which a user can visualize through the film.

10. A method of adhering a film to a hand, comprising the steps of:
providing a dispenser according to claim 1;
loading a roll of the flexible film into the housing;
drawing the film over the base member such that the surface with the adhesive is facing outwardly; and
pressing the palmar surface of a hand against the film and base member.

13. The method of claim 11, wherein the dispenser further includes a cutting edge, and wherein the method further includes the step of:

drawing the film adhered to a hand past the film-separation edge; and
applying a force with the hand to sever the film at the cutting edge.

14. The method of claim 10, wherein the film includes spaced-apart perforation regions to

assist in severing the film.

17. The method of claim 10, wherein the base member includes hand-positioning visual indicia, and wherein the method includes the step of visualizing the indicia through the film prior to the step of pressing the palmar surface of a hand against the film and base member.